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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,104	09/25/2006	Wouter De Graaff	2004.834US	7020

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ORGANON USA, INC.
c/o Schering-Plough Corporation
2000 Galloping Hill Road
Mail Stop: K-6-1, 1990
Kenilworth, NJ 07033

EXAMINER

DICKINSON, PAUL W

ART UNIT	PAPER NUMBER
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1618

NOTIFICATION DATE	DELIVERY MODE
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06/02/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jill.corcoran@spcorp.com
patents@spcorp.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/594,104	Applicant(s) DE GRAAFF ET AL.	
	Examiner PAUL DICKINSON	Art Unit 1618	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-11 and 13-19.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Michael G. Hartley/
 Supervisory Patent Examiner, Art Unit 1618

/PAUL DICKINSON/
 Examiner, Art Unit 1618

Continuation of 3. NOTE: The subject matter of new claims 20 and 21 was not previously considered.

Continuation of 11. does NOT place the application in condition for allowance because: The rejection of claims 1-11 and 13-16 under 35 U.S.C. 102(b) as being anticipated by EP 0876815 (EP '815) is maintained.

Applicant argues that the drug delivery system disclosed by EP '815 does not disclose a concentration of a progestogenic compound below the saturation level at 25 oC. In contrast, EP '815 teaches a relatively low degree of supersaturation. While claim 4 of EP '814 teaches a concentration of about one but not more than about 6 times the saturation level, the reference as a whole teaches that supersaturation means that the progestogenic compound is present in a concentration of at least the saturation level, and does not include values below the saturation level. EP '815 further fails to appreciate Applicant's discovery that keeping progestogenic compounds below the saturation level at 25 oC allows them to be stored above room temperature.

Applicants arguments have been fully considered but are not found persuasive. A reference may be relied on for all it teaches, and is not limited by preferred embodiments or examples. EP '815 teaches embodiments wherein the concentration of the progestogenic compound is about one times the saturation level at 25 oC (claim 4), and further teaches the importance of keeping the compound dissolved in a low concentration to improve the shelf life. The Examiner maintains that one would instantly envision values at or just under the saturation level to afford a product with a prolonged shelf life. That EP '815 does not appreciate that keeping the progestogenic compound below the saturation level allows for storage above room temperature is not material to the basis of the rejection. The instant claims do not recite this limitation. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)." MPEP § 2112, I.

The objection of claims 17-19 under 37 CFR 1.75(c) is maintained. The rejection of claims 17-19 under 35 U.S.C. 112, second paragraph, is maintained. The rejection of claims 17-19 under 35 U.S.C. 102(b) as being anticipated by van Laarhoven et al 2002b (*International Journal of Pharmaceutics*, 2002) is maintained..